

**REMARKS**

Claims 1-4 and 7-16 remain in the application with Claim 1 being independent. Claims 3 and 4 have been withdrawn from consideration and claim 10 has been amended by the present amendment.

The Examiner rejected Claims 1, 2, and 7-16, under 35 U.S.C. § 112, first paragraph, as containing subject matter not described in the specification. Specifically, the Examiner stated, "Applicants have failed to indicate how the specification supports the 'mutually exclusive of' and 'structurally distinct' language of claim 1".

The phrase "mutually exclusive of" is intended to convey that Claim 1 requires components b11, b12, b14 and, optionally, b13. The language was intended to convey that no single component can function as, for example, b11 and b14. Throughout the specification each of these components is discussed separately and it is clear that each is a separate specific component. Thus, although the functionalities and molecular weight ranges have overlapping portions the claim clearly delineates that at least components b11, b12, and b14 need to be present. With respect to the structurally distinct language, it is clear from the claim language that b11 is structurally distinct from b12 as one is a hydroxyl functional initiated polyether and the other is an amine functional initiated polyether. Also, some of the components falling within the limitations for b13 would have higher functionality and molecular weight than either components b11 or b12. In addition, component b14 is limited to a bifunctional component whereas the other components can range from 1.5 to 5 functional. Thus, Applicants submit that there is support throughout the specification for the recited limitations and respectfully submit that the rejection should be withdrawn.

The Examiner rejected Claim 10 under 35 U.S.C. § 112, second paragraph, as being indefinite for referring to the mixture as “(b)” instead of as mixture “(b1)”. Claim 10 has been amended to address this typographical error. Thus, this rejection is believed to be overcome and should be withdrawn.

The Examiner rejected Claims 1, 2, and 7-16, under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner felt it was unclear what quantities are denoted by the language “a positive amount”. A positive amount is meant to denote that the recited component is there is some amount other than zero. It is believed that this explanation makes definite what is intended by the term “a positive amount”. It would be clear to one of ordinary skill in the art reading the claims that this language intends to convey that some amount other than zero of the component is present in mixture b1. Thus, it is believed that this rejection is overcome and should be withdrawn.

The Examiner rejected Claims 1, 2, 7, 8, 10, 13, and 14, under 35 U.S.C. § 103(a) as being unpatentable over *Schwindt, et al* (‘423) or *Grogler, et al* (‘497).

Presently, independent Claim 1 is directed toward a veneer made from a reaction mixture comprising an isocyanate and a specific mixture of isocyanate-reactive compounds. The mixture of isocyanate-reactive compounds must contain from 15 to 90% by weight of a first polyether polyalcohol that is hydroxyl functional initiated, contains propylene oxide, has a number average molecular weight of from 400 to 6,000, and a mean functionality of from 1.5 to 3. The isocyanate-reactive mixture must further contain a positive amount to 20% by weight of a second polyether polyalcohol that is an amine functional initiated polyalcohol containing propylene oxide, has a number average molecular weight of from 400 to 6,000, and a mean

functionality of from 1.5 to 3. Finally, the isocyanate-reactive mixture must contain a positive amount to 30% by weight of a bifunctional chain extender.

Rejection of a claim under 35 U.S.C. § 103(a) based on a single reference requires that the single reference itself provide the motivation, teaching, or suggestion that would lead one of ordinary skill in the art to modify the cited reference in an obvious manner to produce the rejected claim. When a rejection under 35 U.S.C. § 103(a) is based on a combination of references it is essential that the Examiner point to specific teaching, suggestion, or motivation found within the references themselves that would lead one of ordinary skill in the art to combine the references and through that combination to make obvious Applicants' invention. *In re Sang-Su Lee*, 277 Fed.3d 1338, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

The Examiner admits that the references, either alone or in combination, fail to disclose use of any amine-initiated polyether polyol as required by Claim 1. The Examiner, however, takes the position that the claimed positive amount of the amine initiated polyether polyol is close enough to 0 that one would have reasonably expected the respective compositions to have the same properties at the low end of the second polyether polyol range and cites as support for this *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985).

Applicants submit that the Examiner is mistaken regarding the obviousness of the rejected claims based on either of the cited references alone or in combination and has incorrectly applied the teachings of *Titanium Metals Corp. of America v. Banner*.

*Schwindt, et al* discloses the formation of a polyurethane elastomer by reacting from 90 to 50% by weight of a first compound (A) having a molecular weight of from 400 to 10,000 and

at least two isocyanate-reactive hydrogen atoms with an isocyanate. The reference furthermore discloses use of from 0 to 20% by weight of a chain-lengthening agent having a molecular weight of from 60 to 400. The novelty in *Schwindt, et al* is the utilization of a new catalyst combination of an alkali metal hydroxyl and/or alkaline earth metal hydroxide with an organometallic compound selected from a specific grouping. The *Schwindt, et al* reference states in Column 4, Lines 3-22, that the component (A) comprising from 90 to 50% by weight of the mixture can be either a polyester, a polyether, a polythioethers, or a polycarbonate. There is no teaching in *Schwindt, et al* of the utilization of an isocyanate-reactive mixture comprising 15 to 90% of a hydroxyl-initiated polyether alcohol with an amine-initiated polyether alcohol, and a bifunctional chain extender as required by Claim 1 of the present invention. There is no motivation, suggestion, or teaching in *Schwindt, et al* that would lead one of ordinary skill in the art to modify the isocyanate-reactive portion of the elastomer disclosed in *Schwindt, et al* to encompass that required by Claim 1 of the present invention. A comparison of the properties reported for the examples of *Schwindt, et al* to those reported in Example 3 of the present invention reveal that inclusion of the amine-initiated polyether has a dramatic effect on the properties and that the properties of Shore hardness A, tensile strength, and tear propagation are nowhere near those of the examples disclosed in *Schwindt, et al*.

*Grogler, et al* is even further from the present invention. *Grogler, et al* is directed toward a preparation of a heat-curable reactor system comprising combining a hydroxyl and/or amine-terminated polyoxy alkylene polyether that is a liquid and has a molecular weight of from 400 to 10,000 with a solid hydroxyl and/or amine-terminated polyester having a molecular weight of 400 to 20,000 wherein the solid polyester is thoroughly distributed throughout the

mixture but not homogeneously miscible with the polyether. *Grogler, et al* further discloses that chain-extending agents are an optional component. *Grogler, et al* teaches a method for forming a polyether-polyester polyurethane which is unlike that of the present invention. *Grogler, et al* is specifically directed toward solving the difficulty of producing polyurethane that has a combination of polyesters and polyethers. There is no disclosure in *Grogler, et al* of the utilization of a hydroxyl-initiated first polyether with an amine-initiated second polyether and a bifunctional chain extender as required by Claim 1 of the present invention. *Grogler, et al* provides no teaching, suggestion or motivation that would lead one of ordinary skill in the art to modify *Grogler, et al* to include the components found in Claim 1 of the present invention that are not disclosed whatsoever in *Grogler, et al*.

The Examiner is correct that Claim 1 is open to addition of other components, however, the references do not provide or make obvious the required components of Claim 1.

*Titanium Metals Corp. of America v. Banner* was a situation wherein the prior art reference included all of the components recited within the rejected claim and furthermore disclosed several points falling directly within the cited ranges in the rejected claim. That is not the case in the present invention wherein neither of the cited references include several of the components required by Claim 1 of the present invention. *Titanium Metals Corp. of America v. Banner* is simply not applicable to the present situation.

The tensile strength, tear propagation resistance, and Shore hardness A of all the examples reported in *Schwindt, et al* are very different from those seen for the examples of the present invention and particularly Example 3 of the present invention which includes the amine-functional initiated polyether polyalcohol at a level of 10%.


In summary, Applicants submit that the Examiner has failed to make a *prima facie* case of obviousness based on the cited references. In addition, Applicants submit that even if the Examiner's position of a *prima facie* case of obviousness is accepted, the cited references simply do not make the present invention as embodied in Claim 1, and the claims which depend therefrom, obvious. Therefore, the rejection of Claim 1, and the claims which depend therefrom, under 35 U.S.C. § 103(a) based on *Schwindt, et al* or *Grogler, et al.*, either alone or in combination, is improper and should be withdrawn.

Applicants' attorney respectfully submits that the claims as amended are now in condition for allowance and respectfully requests such allowance.

Respectfully submitted,

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Attorney docket # 12002

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MARKED-UP VERSION

10. (Amended) A veneer as recited in Claim 1, wherein said mixture [(b)] (b1) comprises from a positive amount to 10% by weight of said second polyether polyalcohol.

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